

REMARKS

Claims 1-10 are pending in the application.

Claims 1, 3-8, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,137,604 to Bergano in view of U.S. Patent Application Publication No. 2001/0048540 to Konishi, and further in view of International Patent Application Publication No. WO 02/30026 to Tomofuji et al. (I); claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergano, Konishi, Tomofuji et al. (I), and further in view of U.S. Patent Application Publication No. 2002/0149818 to Tomofuji et al. (II); and claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bergano, Konishi, Tomofuji et al. (I), and further in view of U.S. Patent Application Publication No. 2002/0196520 to Marom et al. Applicants respectfully traverse the rejections.

The Examiner cited Konishi as a combining reference that allegedly suggests selecting a particular dispersion compensation, and relied upon Tomofuji et al. (I) as a combining reference that allegedly suggests the claimed feature of “switching routes of the demultiplexed wavelengths leading to the output ports.” Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness by failing to consider the claimed invention “as a whole” in piecing together disparate features from the cited references to discretely meet the features of the claimed invention.

In particular, the cited portions of Tomofuji et al. (I) only include description of “switching” demultiplexed signals according to bit rates of channels, which may span various wavelengths, to respective inputs of multiplexers (12-1 to 12-m) within a demultiplexing section (40A). Please see, e.g., Figs. 4, 8, and 14 of Tomofuji et al. (I). Therefore, the Examiner has failed to provide any motivation to combine this technique of switching according to bit rate

described in Tomofuji et al. (I) to the disclosure of Bergano wherein a technique has already been provided for passively splitting a multiplexed signal for respective dispersion compensation. In other words, Bergano itself already describes a technique for splitting a signal for dispersion compensation, and the alternative parameters—e.g., bit rate—for “switching” demultiplexed wavelengths described in Tomofuji et al. (I) are incongruous with the technique described in Bergano. Thus, Applicants respectfully submit that it would not have been obvious to one skilled in the art to combine the cited references in the manner proposed by the Examiner, and that the Examiner has failed to establish a prima facie case of obviousness for such a manner of combining the disparate teachings of the references to discretely meet the features of the claimed invention, without considering the claimed invention “as a whole.” MPEP §§ 2141.02 and 2142-2143.01

Furthermore, the respective outputs (12-1...12-m) of a demultiplexing section (40A) described in Tomofuji et al. (I) may include multiplexed output “ports” p1-p4 that span similar wavelength spectra. Please see, e.g., Figs. 4 and 8 of Tomofuji et al. (I). Thus, even assuming, arguendo, that it would have been obvious to one skilled in the art to combine Bergano, Konishi, and Tomofuji et al. (I) at the time the claimed invention was made, such a combination would have, at most, suggested having a same dispersion compensation for multiple respective bit-rate-“switched” demultiplexed signals. And, in other words, such a combination would still have failed to disclose or suggest,

“[a]n apparatus for compensating for dispersion,
comprising:

a wavelength-selective optical switching unit which
receives at one input port thereof a signal into which a plurality of
wavelengths are multiplexed, and demultiplexes the signal so as to
output the demultiplexed wavelengths at desired output ports while

switching routes of the demultiplexed wavelengths leading to the output ports;

a plurality of dispersion compensation units which are connected to the *respective output ports*, and have *respective, different dispersion values*; and

a multiplexing unit which receives at a plurality of input ports thereof the demultiplexed wavelengths output from said dispersion compensation units, and multiplexes the demultiplexed wavelengths to generate a signal,” as recited in claim 1. (Emphasis added)

Accordingly, Applicants respectfully submit that claim 1, together with claims 3 and 5-7 dependent therefrom, is patentable over Bergano, Konishi, and Tomofuji et al. (I), separately and in combination, for at least the above-stated reasons. Claims 4 and 8 incorporate features that correspond to those of claim 1 cited above, and are, therefore, together with claim 10 dependent from claim 8, patentable over the cited references for at least the same reasons. The Examiner relied upon Tomofuji et al. (II) and Marom et al. as combining references to specifically address additional features recited in claims 2 and 9, respectively, which depend from claim 1. As such, further combinations with these references would still have failed to cure the above-described deficiencies of Bergano, Konishi, and Tomofuji et al. (I), even assuming, *arguendo*, that such further combinations would have been obvious to one skilled in the art at the time the claimed invention was made. Accordingly, Applicants respectfully submit that claims 2 and 9, which depend from claim 1, are patentable over the cited references for at least the foregoing reasons.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

/Dexter T. Chang/

Dexter T. Chang
Reg. No. 44,071

CUSTOMER NUMBER 026304

Telephone: (212) 940-6384

Fax: (212) 940-8986 or 8987

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